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BCJ

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/153,782 09/16/98 BJORN

V 03022.P011

WM31/0906
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EXAMINER

MEHTA, B

ART UNIT	PAPER NUMBER
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2621

DATE MAILED:

09/06/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/153,782

Applicant(s)
Bjorn et al

Examiner
Bhavesh Mehta

Art Unit
2621



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on Jul 23, 2001

2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-31 is/are pending in the application

4a) Of the above, claim(s) _____ is/are withdrawn from consideration

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1-31 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirements

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 10

20) ☐ Other: _____

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Response to Amendment/Arguments

1. Applicant's arguments filed 7/23/01 have been fully considered but they are not persuasive. Applicants argue that O'Connor does not teach or suggest using the fingerprint image as a pointer control device. Furthermore, applicants also argue that O'Connor does not teach or suggest using parameters associated with the fingerprint image to configure the use of the fingerprint image. Additionally, applicants argue that O'Connor does not teach or suggest configuring the device to operate as either a pointer control device or a fingerprint recognition device based on certain parameters. The examiner strongly disagrees. With respect to Borza, applicants argue that Borza uses separate devices for cursor control and fingerprint recognition. Here again, the examiner disagrees. With respect to the rejections over the references of Crawford, Rao and Kinsella, the rejections set forth in paragraphs 6 and 7 of the prior office action have been withdrawn.

With respect to applicants argument that O'Connor does not teach or suggest using the fingerprint image as a pointer control device or that O'Connor does not teach or suggest configuring the device to operate as either a pointer control device or a fingerprint recognition device , the examiner would like to point out that the claimed language only calls for the processing device to configure the touchpad device to operate as either a pointer control device or a fingerprint recognition device. It is unclear what is meant by "using the fingerprint image as a pointer control device". It is the processing device that configures the touchpad device to operate

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as a pointer control device and that is exactly what is being taught by both O'Connor and Borza. Applicants attention is also directed to page 8 of the specification at lines 1-14 which shows both the fingerprint data base and the cursor control as either separate components or contained within different control and memory devices maintained within the processing device 105. Nothing in the specification precludes from having separate components for fingerprint recognition or pointer device. In addition to col. 3, lines 22-66, examiner would like to draw applicants attention to col. 6, lines 38-48 which also states the placement of window area 113 in the side of the mouse or in one of the buttons and hence would read on the claimed limitations. Additionally, O'Connor further discloses that the touchpad device is configured to operate as a pointer control device or a fingerprint recognition device based upon an area parameter associated with the fingerprint image (col. 4, lines 1-10; see also figure 2 : 201, 203; col. 6, lines 48-55). With respect to Borza, applicants attention is directed to Figures 15-17. Clearly, Borza uses same devices for cursor control and fingerprint recognition (see col. 11, lines 31 - 59 and col. 14, line 51 - col. 15, line 4).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

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3. Claims 1-2 and 5-31 are rejected under 35 U.S.C. 102(e) as being anticipated by O'Connor et al (US 5838306).

O'Connor discloses substantially the claimed invention(see abstract and figures 1-2) including a touchpad device comprising:

a detection array having a detection surface configured to receive a fingerprint image (Fig 1 : 111, 113; see col. 3, line 50 - col. 4, line 15 and also col. 6, lines 38 - line 55) ;

and a processing device configured to receive the fingerprint image or image data from the detection array and wherein the processing device configures the touchpad device to operate as a pointer control device or a fingerprint recognition device based upon parameters associated with the fingerprint image(col. 3, lines 23-40; Figure 2; col. 4, lines 58-62).

Re claim 2, O'Connor further discloses a fingerprint platform configured to supply a fingerprint image to the detection surface of the detection array(Fig 2 : 201; see also col. 6, lines 48-55).

Re claim 5, O'Connor further discloses that the touchpad device is configured to operate as a pointer control device or a fingerprint recognition device based upon an area parameter associated with the fingerprint image (col. 4, lines 1-10; see also figure 2 : 201, 203; col. 6, lines 48-55).

Re claims 6-7, O'Connor further discloses first and second area median range (see figure 2 : 201 and 203 and col. 3, lines 7-22 wherein the CCD array 311 would encompass a full fingerprint image 201 corresponding to claimed first median range whereas partially processing of

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fingerprint data as set forth in col. 6, lines 62-65 corresponds to claimed second area median range).

Re claim 8, O'Connor further discloses that the touchpad device is configured to operate as a pointer control device or a fingerprint recognition device based upon a pattern parameter associated with the fingerprint image (Fig 3 : 301, 303; col. 4, lines 63-67).

Re claims 9-12, O'Connor further discloses a first pattern which is a full fingerprint pattern and a second pattern which is a finger-tip print pattern (fig 3 discloses a first pattern which is a full fingerprint pattern whereas col. 6, lines 61-65 teaches partially processed fingerprint data corresponding to claimed second pattern which can be a finger-tip print pattern).

Re claim 13, O'Connor further discloses that the processing device is configured to translate the position of the fingerprint image on the detection surface into a cursor position on an interface area of a display when the touchpad device operates as a pointer control device (this is inherently the normal operation of the mouse of Figure 1 or Figure 4; see also at col. 3, lines 23-40).

Re claim 14, O'Connor discloses the both the area parameter and pattern parameter (see figures 2 and 3).

Claims 15-31 are similarly analyzed and rejected as the above claims.

Claim Rejections - 35 USC § 103

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4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Connor in view of Keagy et al (US 5732148).

O'Connor has been discussed above. In fig . 3 , O'Connor illustrates the fingerprint platform (see also col. 4, lines 62-67). However, he fails to specifically teach that the fingerprint platform comprises a sheet prism. However, the use of a sheet prism as a fingerprint platform is well known in the prior art. For example, in Figure 2 (see also Figures 3-4), Keagy discloses the sheet prism (finger print platen 10; see also col. 4, lines 30-35) being used as the fingerprint platform (see col. 6, lines 14-35). It would have been obvious to a person skilled in the art to use platen 10 or the micro prisms as shown by Keagy for fingerprint platform of O'Connor because such a modification will make the system of O'Connor at a sufficiently low cost and also improve the contrast of the fingerprint image(see Keagy at col. 4 lines 48-52 and lines 24-30).

Re claim 4, Keagy at col. 6, lines 20-40 teaches that the sheet prism is configured to focus the fingerprint image onto the detection surface.

6. Claims 1-4, 13, 15-16, 23 and 30-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Borza et al (US 5991431).

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Borza also discloses a mouse adapted to scan biometric data (see abstract, figure 3, col. 3, lines 10-17). Borza further discloses a sheet prism as claimed in claims 3-4(prism 12 in figure 4; see also multi prisms of Figures 23-25).

7. Claims 5-12, 14, 17-22 and 24-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borza et al in view of O'Connor.

Both Borza and O'Connor have been discussed above. Borza fails to specifically disclose some of the limitations such as area parameter and pattern parameter. However, as discussed above, O'Connor discloses the claimed elements missing in Borza. Because, both the references discusses pointing devices incorporating biometric scanners, it would have been obvious to a person with ordinary skill in the art to combine the teachings of Borza and O'Connor for the purpose of reducing space required on a desktop and also allowing normal operation of the pointing device and at the same time providing a security function with out the need for additional hardware.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

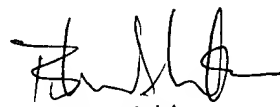
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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bhavesh Mehta whose telephone number is (703) 308-5246. The examiner can normally be reached on Monday-Thursday from 8:00 AM to 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo Boudreau, can be reached on (703) 305-4706. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700 or to the Customer Service Office at (703)306-0377.



Bhavesh Mehta
Primary Examiner

Attachment for PTO-948 (Rev. 03/01, or earlier)
6/18/01

The below text replaces the pre-printed text under the heading, "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

1. Correction of Informalities -- 37 CFR 1.85

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability. Extensions of time may **NOT** be obtained under the provisions of 37 CFR 1.136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made other than correction of informalities, unless the examiner has approved the proposed changes.

Timing of Corrections

Applicant is required to submit the drawing corrections within the time period set in the attached Office communication. See 37 CFR 1.85(a)

Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.